

Appl. No. 10/697,225
Docket No. 9396L
Amdt. dated September 11, 2008
Reply to Office Action mailed on June 11, 2008
Customer No. 27752

REMARKS

Claim Status

Claims 7 - 12 are pending in the present application, and stand rejected. Claims 1-6 and 13-30 have previously been canceled. No additional claims fee is due.

Remarks on Claims and Related Application

U.S. Application No. 11/281,791, filed November 17, 2005 is a division of the instant application. The '791 application currently has Claims 1 and 3-5 pending, all of which stand rejected. These claims were amended in a response to an outstanding office action, the response having been filed on August 28, 2008 and not yet acted upon by the Examiner. Pending Claims 7-12 of the instant application are not identical to those in the '791 application, but have some similar features.

Rejection Under 35 USC §102(b) Over Inoue et al.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al. (US 6,630,096 B1). Contrary to the position in the Office Action, Claim 7 is not anticipated by the Inoue et al. document.

The Office Action on pages 2-3 sets forth definitions of the terms "visible" and "visible highlighting" that essentially correspond to those given explicitly in the specification. While the Office Action purports to be applying these definitions, in fact, this does not appear to be the case as will be shown in more detail below. On pages 3-4 of the Office Action, there is a recitation of findings of where various claim elements are supposedly taught in the Inoue et al. document. These findings do not address the claim feature of the visible highlighting comprising an ink-printed pattern. As will be discussed in more detail below, the Office Action assumes that this claim feature may simply be ignored as not "lend[ing] additional patentable weight."

Appl. No. 10/697,225
Docket No. 9396L
Amdt. dated September 11, 2008
Reply to Office Action mailed on June 11, 2008
Customer No. 27752

When addressing the claim feature of visible highlighting generally (as opposed to the specific type of visible highlighting claimed — namely a highlighting comprising an ink-printed pattern), the Office Action misapplies the definition it purports to be using on pages 2-3. The wetness sensation member is described on pages 4 and 5 as being “visible” in the sense that it can be seen when someone looks at it. This is undoubtedly true. However, the claim requires more than that the wetness sensation member be “visible” (presumably as opposed to being invisible). Paragraph 5 on page 5 of the office action makes the finding that “Inoue teaches that the at least one wetness sensation member (22,26) is integrated with the topsheet (2), thus **inevitably and necessarily it is visible because the topsheet is visible.**” (emphasis added). It is not disputed that the topsheet of the Inoue et al. is visible. Furthermore, it is not disputed that the portion of the article in Inoue et al. characterized as the wetness sensation member is visible. Even accepting the reasoning of the Office Action, Inoue, et al. at best suggests a wetness sensation member that “would appear different in appearance from the remaining portions of the topsheet.” (Office Action, Para. 7). Even this finding, however, has not been established. Inoue et al. does not disclose that the wetness sensation member of the article has a highlighting which causes it to **noticeably stand out from its surroundings.** (The express definition given in the specification).

The Office Action assumes in paragraph 6 that any difference (such as size and material properties) is sufficient to conclude that the wetness sensation member must therefore **noticeably stand out** from its surrounding. This is simply not the case. A quarter placed on a stainless steel table would not necessarily noticeably stand out from the table. This can be true even if the size of the two and material composition of the two are different. In this anticipation analysis, the Office Action is simply assuming the existence of a claim limitation which has not been demonstrated as inherently or expressly disclosed.

Additionally, Claim 1 requires that the visible highlighting comprise an ink-printed pattern and that the visible highlighting be visible prior to wetting of the absorbent article. These features are not taught by Inoue, et al. either. The Office Action has dismissed the claim limitation regarding the ink printed pattern nature of the visible highlighting as being “a product by process limitation” which is “not germane to the issue of patentability of the article itself.” The features of the visible highlighting expressly

Appl. No. 10/697,225
Docket No. 9396L
Amdt. dated September 11, 2008
Reply to Office Action mailed on June 11, 2008
Customer No. 27752

recited in Claim 1 are not “product by process limitations” and must be considered when evaluating patentability. Nothing in Claim 1 is drawn to the particular method of printing used. Rather, Claim 1 is directed to a particular **species of the claimed visible highlighting** (i.e. one that comprises an ink-printed pattern visible before the article is wetted). The Office Action seems to use the fact that the specification discloses that visible highlighting can be provided in a variety of ways (i.e. embodiments) as evidence that the claim feature is “not critical but is purely a matter of design choice.” This argument has no place in an anticipation analysis. All claim features are material and must be found in the prior art. The fact that the **applicants** have disclosed a variety of structures which could meet the limitation does not mean that **any** structure could. Additionally, the claim is now directed to particular species of the claimed visible highlighting. This serves to more clearly **distinguish it** from the Inoue et al. document. It is legal error to simply ignore this feature and dismiss it out of hand.

The visible highlighting comprising an ink printed pattern as claimed is a **structural** difference between the claimed article and the characterization given by the Office Action of the articles of Inoue et al. The Office Action seems to maintain the position that any difference in properties in an article would be “visible.” While this reading of the references is not correct, the Applicants have amended the claim to focus on a particular structure which may effectively create the claimed visible highlighting – namely, one in which the highlighting is in the form of an ink-printed pattern. The advantages of such features are described in the specification and the features have not been shown to be taught in the reference. Therefore, when all claim features are properly considered, Amended Claim 1 and the claims which depend from it must be considered patentable over the cited references.

Appl. No. 10/697,225
Docket No. 9396L
Amdt. dated September 11, 2008
Reply to Office Action mailed on June 11, 2008
Customer No. 27752

Rejection Under 35 USC §103(a) Over Inoue et al.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (US 6,630,096 B1). Claims 8 and 9 depend from Claim 7. The basic rejection of Claims 8 and 9 stems from the previously discussed rejection of Claim 7 over the same reference. The analysis given with respect to Claims 8 and 9 in the Office Action does nothing to cure the deficiencies noted above. Therefore, the rejections of Claims 8 and 9 are improper for at least the reasons given above with respect to Claim 7.

Additionally, it is noted that paragraph 9 of the Office Action merely concludes that “multiples of the same structure do not lend additional patentable weight and is an obvious modification.” This reasoning is not correct. Additional instances of a particular structure **may or may not be obvious**. The Office Action purports to be applying Graham v. John Deere, but there is no analysis regarding why these particular differences between the reference and Claims 8 and 9 are obvious. It is simply not true that in all cases multiples of the same structure are obvious. Without any line of reasoning showing that these difference would have been obvious here, there is no *prima facie* case of obviousness. Therefore, these rejections should be withdrawn.

Rejection Under 35 USC §103(a) Over Inoue et al. in view of Igaue et al.

Claim 10-12 have been rejected under 35 USC §103(a) as being unpatentable over Inoue et al. (US 6,630,096) in view of Igaue et al. (GB 2,244,201A). Claims 10-12 depend from Claim 7. The basic rejection of Claims 8 and 9 stems from the previously discussed rejection of Claim 7 over Inoue et al. now with the addition of Igaue et al. The analysis given with respect to Claims 10-12 in the Office Action does nothing to cure the deficiencies noted above. Therefore, the rejections of Claims 10-12 are improper for at least the reasons given above with respect to Claim 7.

The Office Action makes a summary conclusion that “when there are a variety of possible location is means that the designer can choose any location he wants; and it has been held that rearranging parts of an invention involves only routine skill in the art.” Both parts of this quoted conclusion are beside the point and do not establish the showing required. Even if it is the case that the designer can locate a structure “in any location he

Appl. No. 10/697,225
Docket No. 9396L
Amdt. dated September 11, 2008
Reply to Office Action mailed on June 11, 2008
Customer No. 27752

wants," this fact, by itself, does not establish the **desirability** (or obviousness) of locating it **in the manner claimed**. Even if a modification can be made to a prior art article with the exercise of "routine skill" this does not establish obviousness. At most, this establishes that the modification **could** be made. A *prima facie* case of obviousness requires some reasoning that the modification **would be made**. The Office Action has put forth no analysis under any of the categories set forth in KSR which would support a *prima facie* case of obviousness. Therefore, the rejections of Claims 10-12 are improper and should be withdrawn.

Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied reference(s). In view of the foregoing, reconsideration of this application, and allowance of the pending claim(s) are respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By /Matthew P. Fitzpatrick/
Matthew P. Fitzpatrick
Registration No. 41,751
(513) 634-4287

Date: September 11, 2008
Customer No. 27752
(Amendment-Response to Office Action.doc)
Revised 11/17/2006